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THIS DISPOSITION IS NOT CITABLE AS PRECEDENT OF THE T.T.A.B.

Paper No. 32
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UNITED STATES PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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First American Fastrac Systems, Inc.
(by name change from Fastrac Systems, Inc.) and
First American Corp. (joined as party plaintiff)
v.
Empire Fire and Marine Insurance Co.

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Opposition Nos. 110,976 and 111,126
to application Serial Nos. 75/332,798 and 75/332,799
both filed on July 7, 1997

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Gerald S. Schur of Welsh & Katz, Ltd. for First American Fastrac Systems, Inc. and First American Corp.

Robert D. Hovey of Hovey, Williams, Timmons & Collins for Empire Fire and Marine Insurance Co.

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Before Chapman, Walters, and Drost, Administrative Trademark Judges.

Opinion by Drost, Administrative Trademark Judge:

Empire Fire and Marine Insurance Co. (applicant) has filed two trademark applications to register the mark FASTRACK in typed form and in stylized form for services identified as “insurance claims processing via a 24-hour insurance claim and accident reporting hotline” in International Class 36. Application Serial No.

75/332,798 is for the mark FASTRACK in typed form; application Serial No. 75/332,799 is for the mark FASTRACK in stylized form[1].

On June 30, 1998, and July 7, 1998, Fastrac Systems, Inc. (opposer) filed notices of opposition to the registration of the two applications discussed above. Opposer based its opposition, inter alia, on its ownership of Registration No. 1,604,117 for the mark FASTRAC (typed form) for services identified as "computer services, namely, providing access time to a computer database in the field of insurance information to mortgage lenders" in International Class 42.[2]

On March 26, 1999, the Board granted the parties' joint motion to consolidate the two oppositions.

[1] Both applications were filed on July 7, 1997, and alleged dates of first use and first use in commerce of July 1, 1997. An amended drawing showing the mark as solid black was ultimately accepted in the '799 application.

[2] The registration issued June 26, 1990, and the filing date of the underlying application was March 10, 1989. An affidavit under Sections 8 and 15 has been accepted and acknowledged, respectively; renewed.

The Record

The record consists of the files of the involved applications; the trial testimony deposition, with accompanying exhibits, of Mark Speizer, former chairman and chief executive officer of Fastrac Systems, Inc.; a status and title copy of opposer's Reg. No. 1,604,117; opposer's documents concerning various agreements it has with its customers; Certificates of Amendment of Articles of Incorporation for Fastrac Systems, Inc. and National Insurance Group; a copy of *Vehicle Leasing Today* magazine; a Securities and Exchange Commission 10-K filing for National Insurance Group; a 1999 annual report for First American Financial Corporation; copies of cases and legal articles and papers related to various oppositions at the Board involving opposer; and applicant's submission of over 150 U.S. trademark registrations containing the term "fast track" or some variation of it.

Both parties have filed briefs, but no oral hearing was requested.

Priority

Priority is not an issue to the extent that the opposition is based on opposer's ownership of a registration for the mark FASTRAC. See King Candy Co. v.

Eunice King's Kitchen, 496 F.2d 1400, 182 USPQ 108 (CCPA 1974). To the extent that opposer relies on its common law trademark rights or its trade name usage of the term FASTRAC for various insurance-related services, it has established that it has used the term prior to the filing date of the opposed applications.

The original notices of opposition in this case were filed by Fastrac Systems, Inc., which was a wholly-owned subsidiary of National Information Group. Opposer's Ex. 4, p. F000139; Opposer's Ex. 28, p. F0003350. On June 15, 1998, National Insurance Group had changed its name to National Information Group. Opposer's Ex. 31. National Information Group merged with First American Financial Corporation. Opposer's Ex. 29, p. F0003446. On May 9, 2000, Fastrac Systems, Inc. amended its Articles of Incorporation to indicate that its name is First American Fastrac Systems, Inc. Opposer's Ex. 30.

On October 18, 2000, First American Corporation (formerly First American Financial Corporation) moved to amend the notice of opposition to conform to the evidence under Fed. R. Civ. P. 15(b) and indicate that First American is the owner of the registration. The motion was unopposed, and the Board granted the motion in an order dated February 13, 2001.

"[A]n opposer is not limited in an opposition to relying solely on those marks for which it has registrations. An opposer can rely upon other forms of its marks or indeed other marks for which it lacks registrations, provided opposer is the prior user." Fossil Inc. v. Fossil Group, 49 USPQ2d 1451, 1454 (TTAB 1998). In this case, opposer has alleged that it is using its mark on services beyond those described in its registration and also that it is using the term FASTRAC as a trade name. Opposer argued that its "prior use, by a related company of a term as a trade name or corporate name is a proper ground itself for opposition and is sufficient to preclude registration of a singular term for related goods or services." Br., p. 7. Opposer is correct that the use of a term not as a technical trademark, such as use as a trade name or corporate name, can be a proper ground for opposition to the registration of a similar term. Jim Dandy Co. v. Martha White Foods, Inc., 458 F.2d 1397, 173 USPQ 673, 675 (CCPA 1972); Cyber-Tronics, Inc. v. Johnson Service Co., 156 USPQ 583 (TTAB 1967). In order to prevail on its use of a common law trademark or a trade name, the common law mark or trade name must be pled or tried by consent of the parties. Fossil, Inc., 49 USPQ2d at 1454.

While not a model of clarity, opposer's original and amended notices of opposition put applicant on notice that opposer was relying on more than its simple ownership of a trademark registration as its bases for opposing the registration of the involved applications.

> Opposer is now and has for many years, through itself and its predecessors, been engaged in intrastate and interstate commerce in connection with the provision of insurance information services, including vehicle insurance tracking, data management, and claims processing analysis. Notice of Opposition, ¶ 1; See also Amended Notice of Opposition, ¶ 1 (same language).
>
> Some of Opposer's services are included in the description of the services in United States Service Mark Registration No. 1,604,117. Notice of Opposition, ¶ 2; See also Amended Notice of Opposition, ¶ 2 (same language).
>
> Opposer also provides and has provided additional services in the insurance field and provides insurance information to customers in other fields, for example, to mortgage lenders, including vehicle manufacturers and lenders, including insurance claims analysis and information. Opposer's services are marketed with the services of other members of the [National Information] Group, which includes automobile physical damage coverage. Notice of Opposition, ¶ 2; See also Amended Notice of Opposition, ¶ 2 (same language).

Opposer's evidence shows that it was using the term "Fastrac" as part of its name at least as early as 1992 and its use was not limited to mortgage lenders. Opposer's Ex. 1; Speizer testimony dep., p. 11 (Mark A. Speizer & Co. changed its name to Fastrac Systems, Inc., in 1992); Opposer's Ex. 3, p. F00060; Speizer testimony

dep., pp. 13-14 ("Fastrac … was also in the business of tracking whether insurance was in place on automobiles, trucks, boats, and other personal property which had been used as collateral to secure loans").

Opposer's evidence establishes priority of its use of its common law mark and trade name prior to the filing date of the applications in this opposition.

Likelihood of Confusion

To determine whether there is a likelihood of confusion in this case, we rely on the factors set out by our primary reviewing court's predecessor, the Court of Customs and Patent Appeals, in In re E.I. du Pont de Nemours & Co., 476 F.2d 1357, 1361, 177 USPQ 563, 567 (CCPA 1973). In considering the evidence of record on these factors, we keep in mind that "[t]he fundamental inquiry mandated by §2(d) goes to the cumulative effect of differences in the essential characteristics of the goods and differences in the marks." Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We first look at whether the marks of applicant and opposer are similar in their entireties as to appearance, sound, connotation and commercial impression. Applicant's marks are for the same term FASTRACK in typed

and stylized form. Opposer's mark is for the mark FASTRAC in typed form. The typed drawings are identical except that applicant spells its mark with the letter "k" at the end. "Applicant concedes that there is little difference in sound or meaning between FASTRAC and FASTRACK." Applicant's Br., p. 7. Indeed, it is difficult to conceive of even a little difference between the two marks as far as sound and meaning are concerned. As to appearance, the two marks have very similar appearances, and it is highly likely that consumers may not even notice the difference between the two marks because the only difference is a letter that does not change the pronunciation or meaning of the word. The two marks' commercial impressions are virtually identical and we can perceive of no meaningful differences between the marks that would help avoid a likelihood of confusion.[3]

Next, we look at the similarity or dissimilarity of the services as described in the applications and the registration as well as the opposer's use of the mark on

[3] Differences in type styles between opposer's mark and applicant's stylized mark are not significant here because the opposer's registered mark is in typed form and, thus, not limited to any special form. Squirtco v. Tomy Corp., 697 F.2d 1038, 1041, 216 USPQ 937, 939 (Fed. Cir. 1983); Cunningham v. Laser Golf Corp., 222 F.3d 943, 55 USPQ2d 1842, 1847-48 (Fed. Cir. 2000).

services outside the identification of services in its registration. Regarding applicant's services, we must view them as they are described in the applications to determine if there is a likelihood of confusion with opposer's mark as used on its services. Canadian Imperial Bank v. Wells Fargo Bank, 811 F.2d 1490, 1493, 1 USPQ2d 1813, 1815 (Fed. Cir. 1987). Applicant argues that merely because both parties are in the insurance field, it does not mean that there is automatically a likelihood of confusion when similar marks are involved. Furthermore, applicant maintains that even if both services use software programs to process data, it does not necessarily follow that use of similar marks leads to a conclusion that confusion is likely. We agree with the applicant regarding the general proposition that merely because similar marks are used in the insurance field and the services involve software, there is no per se rule that confusion is likely.

If this case were limited to a comparison of the services in the applications with those in opposer's registration, there would be some doubt as to whether there is a likelihood of confusion.[4] Applicant's services

[4] Of course, if we had any doubts, we must resolve these doubts about confusion against the newcomer. Kenner Parker Toys v.

concern a 24-hour claim and accident reporting hotline while opposer's registration is for computer services of providing access time to a computer database in the field of insurance information to mortgage lenders. Even with these services, there is a relationship between the two services because applicant's hotline service can be marketed to mortgage lenders who need to make claims on property in which their
institution has a security interest. These situations could occur when the borrower allowed its insurance to lapse and the lender acquired insurance for the collateral ("forced-place insurance"). Speizer testimony dep., p. 43. In such a case, the lenders would be prospective purchasers of both the computer database services of opposer and a hotline

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Rose Art Industries, 963 F.2d 350, 355, 22 USPQ2d 1453, 1458 (Fed. Cir. 1992).

service similar to applicant's to make claims under its insurance policy. We note that the identifications of services in the applications are not limited to hotline services for any particular type of property.

However, in addition to its services identified in its registration, opposer has also submitted evidence that it is the source of additional insurance services under the trademark or trade name FASTRAC. Opposer has been using its mark on services beyond those offered to mortgage lenders. "From real estate mortgages to car, boat, farm equipment, and miscellaneous collateral loans and leases, FASTRAC's multiple tracking capability lets you track your whole portfolio." Opposer's Ex. 5, F000014.

In addition, the record indicates that there was a subsidiary of opposer named "Fastrac Systems, Inc., Insurance Agent & Broker." Speizer testimony dep., p. 17. See also Opposer's Ex. 1. In its 1996 Annual report, Fastrac Systems, Inc. Insurance Agent & Broker was identified as a subsidiary of National Insurance Group. Opposer's Ex. 2, p. F00040. In its 1997 Annual Report, National Insurance Group apparently changed the name of this subsidiary. Opposer's Ex. 4, p. F000139 ("Pinnacle Management Solutions Insurance Services, a

California Corporation ('PMSIS'), formerly named Fastrac Systems, Inc., Insurance Agent & Broker"). National Insurance Group eventually changed its name to National Information Group (Opposer's Ex. 31), and it was subsequently merged with First American Financial Corp. (Opposer's Ex. 29, p. F0003446).

The evidence establishes that throughout this period opposer has used the term "FASTRAC" in relation to various insurance services. Over a period of many years, Fastrac Systems, Inc. Insurance Agent and Broker was licensed to provide various insurance services in many states. See, e.g., Opposer's Ex. 19, pp. F00204 ("Fastrac Systems, Inc. Ins Agent and Broker" licensed by the State of Alaska for providing property, casualty, surety, and marine insurance, effective April 28, 1998), F000206 ("Fastrac Systems, Inc. Insurance Agt & Brkrs" licensed by the State of Arizona, effective April 30, 1998); and F000206 ("Fastrac Systems, Inc. Ins Agt & Brkrs" licensed by the State of Arizona, effective April 30, 1992). Also, information available on opposer's website describes Fastrac Systems, Inc. as "a provider of technology-based automobile tracking services." Opposer's Ex. 14, p. F001771.

Finally, we note that Fastrac Systems, Inc. Insurance Agent and Broker has served as an agent for applicant in various states. Speizer testimony dep., pp. 53-56. See specifically Speizer testimony dep. at pages 55-56.

> Q. You've pointed out on several of these that Fastrac Systems, Inc., Insurance Agent & Broker was a licensee or appointee of Empire Fire and Marine Insurance Co. Do you have an idea of how many states those licenses or appointments were present in?
>
> A. Well, at various times, but at one time it was something like 45 or 46 states.

See also Opposer's Ex. 19, pp. F000271 and F000296.

Fastrac Systems, Inc., Insurance Agent and Broker had an agency relationship with applicant, explained by Mr. Speizer, as follows:

> Whenever the borrower's insurance would lapse, Fastrac would place the insurance – excuse me – it would get information; it would put it into its computer; it would send out letters to the borrowers saying the insurance had lapsed; it would receive telephone calls from the borrowers and agents in response to those letters.
>
> It would either receive a reinstatement or a new insurance policy replacing the one that lapsed, or in the event that did not occur, then it would go ahead and put in place what we'll call "forced placed insurance," which covered the item used as collateral for the loan.
>
> And it handled the money transactions between the financial institutions and the insurance company where the premium went. That would be both getting the money from the institution, paying the insurance company, and then if the policy was ultimately

> cancelled because the borrower finally submitted insurance, then it would go ahead and return the money to the proper payer.

Speizer testimony dep., pp. 17-18.

Later, opposer's witness further described the services its subsidiary performed as a licensee or appointee of applicant:

> We filed the programs with the various states, got the programs accepted to meet the criteria of each individual department, produced the forms, ultimately marketed the product to financial institutions to be used in –- along with our tracking and outsourcing services, issued the policies, cancelled the policies, kept track of premiums received, premiums to be returned, and also received the claims, made claim assignments, and helped settle out claims and pay claims.

Speizer testimony dep., pp. 56-57.

Opposer's witness also testified that in the course of these responsibilities, Fastrac would have been contacted by the insured of these policies. Speizer testimony dep., p. 57. Thus, while opposer's services are targeted to financial institutions and other commercial entities, the record shows that opposer or its subsidiaries using the term FASTRAC would have had contact with purchasers or users who would also be prospective purchasers or users of applicant's services. The overlap in prospective purchasers would not be *de*

minimis. In re Shell Oil Co., 992 F.2d 1204, 26 USPQ2d 1687, 1690 (Fed. Cir. 1993).

In order to support a determination that the goods or services are related, it is not necessary that respective goods or services be identical or even competitive. If the goods or services are marketed in such a way that would lead customers to a mistaken belief that they originate from or are in some way associated with the same producer or that there is some association or connection between the producers of the respective goods, the goods are related. Recot Inc. v. Becton, 214 F.3d 1322, 54 USPQ2d 1894, 1898 (Fed. Cir. 2000); In re International Telephone & Telegraph Corp., 197 USPQ 910, 911 (TTAB 1978).

Here, opposer has established that its services are not limited to the services set out in its registration, i.e. to mortgage lenders. It is clear that opposer has used the term FASTRAC as a trademark or as part of its trade name on diverse insurance services, including acting as applicant's agent or appointee in many states. The purchasers and users for both parties' services overlap and the services themselves are sufficiently related that, if identified by substantially similar marks, confusion as to source or sponsorship is likely.

In addition to its argument regarding the differences in services, applicant argues that there is no likelihood of confusion because the mark is weak as demonstrated by its submission of over 150 registrations it has made of record by a notice of reliance. We are not persuaded by this evidence that there is no likelihood of confusion.

> Much of the undisputed record evidence relates to third party registrations, which admittedly are given little weight but which nevertheless are relevant when evaluating likelihood of confusion. As to strength of a mark, however, registration evidence may not be given *any* weight.

Olde Tyme Foods Inc. v. Roundy's Inc., 961 F.2d 200, 22 USPQ2d 1542, 1545 (Fed. Cir. 1992) (emphasis in original).

Nearly all of these registrations are irrelevant. The fact that the Office has registered such marks as FAST TRAX SUNDAE for ice cream, FASTRAC for plastic safety glasses, or FASTRAK for air transportation services hardly establishes that there is no likelihood of confusion in this case.

Applicant specifically points to six of these registrations on pages 5-6 of its brief as apparently the most relevant ones. Even here, these few registrations are easily distinguished on their face. Vehicle

repossession services, educational seminars, software for inventory management or banking regulation compliance, and mortgage processing all seem to be sufficiently distinct from applicant's and opposer's services. Furthermore, applicant has presented no evidence that these marks have actually been used and the presence of these third-party registrations in the record does not support the registration of other marks when the marks in this case are virtually identical and the services are related. Helene Curtis Industries Inc. v. Suave Shoe Corp., 13 USPQ2d 1618, 1622 (TTAB 1989) ("Third-party registrations are of little weight in determining likelihood of confusion. They are not evidence of use of the marks shown therein and they are not proof that consumers are
familiar with them so as to be accustomed to the existence of similar marks in the market place")[5].

[5] To the extent that applicant alleges that the term FASTRAC is merely descriptive, we note that opposer's registration is over five years old and thus, even if a cancellation proceeding were filed, the registration could not be attacked on the ground of descriptiveness. 15 U.S.C. § 1064(3). Second, even if we were only addressing the issue regarding opposer's common law rights, we do not find that opposer's witness has admitted that the term is descriptive. See Applicant's Br., p. 9; Speizer testimony dep., pp. 71. Finally, applicant has not pointed to any other evidence in the record that would support a finding that the term is merely descriptive.

The purchasers of opposer's services identified by its common law FASTRAC mark are not limited to financial institutions. Applicant's Br., p. 15. Even though the people who actually purchase opposer's services identified in its registration would likely be sophisticated purchasers of such services, opposer has established that it also uses its mark in connection with claim processing, which would be similar to applicant's services.

Because applicant and opposer are both involved in processing claims and interacting with the public, we cannot discern significant differences in the channels of trade or the prospective purchasers, which, if present, would be factors indicating that confusion is unlikely.

Finally, we address applicant's other arguments that confusion is unlikely. Applicant argues that the lack of actual confusion over a three year period should be "persuasive of the conclusion that there is no likelihood of confusion." Applicant's Br., p. 17. The absence of actual confusion does not mean that there is no likelihood of confusion. Giant Food, Inc. v. Nation's Foodservice, Inc., 710 F.2d 1565, 218 USPQ 390, 396 (Fed. Cir. 1983); J & J

Snack Foods Corp. v. McDonald's Corp., 932 F.2d 1460, 18 USPQ2d 1889, 1892 (Fed. Cir. 1991). This factor is particularly less important in this case where applicant has not submitted any evidence regarding the nature and the extent of the use of its mark. Applicant also contends that opposer's evidence of fame has not established that opposer's mark has achieved widespread recognition and renown. While we agree with applicant's point, we note that fame is not required to find confusion in this case.

Likelihood of confusion is decided upon the facts of each case. Dixie Restaurants, 105 F.3d 1405, 1406, 41 USPQ2d 1531, 1533 (Fed. Cir. 1997); Shell Oil, 992 F.2d at 1206, 26 USPQ at 1688. The various factors may play more or less weighty roles in any particular determination of likelihood of confusion. Shell Oil, 992 F.2d at 1206, 26 USPQ2d 1688; du Pont, 476 F.2d at 1361, 177 USPQ at 567.

In this case, the marks of the parties are virtually identical. The services of both parties are in the field of insurance. Opposer has served as applicant's agent and provided claims processing services under the trade name for its subsidiary Fastrac Services Inc. Insurance Agent and Broker. Opposer has established that it uses

its mark FASTRAC outside the mortgage lender field, e.g. it is also used for car and boat leasing. Applicant's identification of services encompasses processing insurance claims via a 24-hour insurance claim and accident reporting hotline for automobile claims. The record supports a conclusion that the services are related.

While we have considered the lack of actual confusion, the third-party party registrations, and the differences in the marks and the services, we find these factors are outweighed by the similarities of the marks and services.

Decision: The oppositions are sustained and registration to applicant of the marks in each of its two applications is refused.